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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/492,137 | 01/27/2000 | Takayuki Watanabe | | 9482 |
| 7590 | 09/08/2004 | | EXAMINER | |
| WENDEROTH, LIND & PONACK, L.L.P. 2033 K Street Suite 800 Washington, DC 20006 | | | | MADSEN, ROBERT A |
| | | ART UNIT | PAPER NUMBER | 1761 |

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|---------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/492,137 | WATANABE ET AL. |
| | Examiner Robert Madsen | Art Unit 1761 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on June 7, 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-4,6,8,10-13 is/are pending in the application.
 4a) Of the above claim(s) 11 and 13 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-4,6,8,10,12 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-4,6,8,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shisheido (JP06040845 A) in view of Hattori (JP 06157238A).
3. See the reasons stated in the Office Action mailed March 5,2004.
4. Claims 1,6,8, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al. (JP 10056969 A) in view of Morimoto et al. (JP 10066516).
5. See the reasons stated in the Office Action mailed March 5,2004.

Response to Amendment

6. The Declaration under 37 CFR 1.132 filed June 7, 2004 is insufficient to overcome the rejection of Claims 1-4,6,8,10 under 35 U.S.C. 103(a) as being unpatentable over Shisheido (JP06040845 A) in view of Hattori (JP 06157238A) and Claims 1,6,8, 10 and 12 under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al. (JP 10056969 A) in view of Morimoto et al. (JP 10066516) as set forth in the last Office action because: facts presented are not germane to the rejection at issue. It include(s) statements which amount to an affirmation that the claimed subject matter

functions as it was intended to function. The experiments provided are directed to *the primary reference* and not the *combination of references*. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

7. Applicant's arguments filed June 7,2004 have been fully considered but they are not persuasive.
8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
9. With respect to applicant's arguments directed to the Declaration, as discussed above in paragraph 6, the experiments compare the *primary references*, but fail to show the *combination of references*, which is the rejection at issue.

10. With respect to Shiseido, Shiseido teaches a solid powder containing trehalose and a water soluble polymer for the intended purpose of providing a non-sticky, stable cosmetic that maintains moisture and perfume. Hattori et al. also teaches a cosmetic that retains moisture for an extended shelf life using water soluble polymers. However, Hattori et al. discloses that conventional water soluble polymers have faults and directs the skilled artisan to selecting hemicellulose (at the recited molecular weight and percentage) as a preferred water soluble polymer for stable cosmetics that maintain moisture (English Abstract, Specification Paragraphs 0001-0007, 0011, 0015-0020). The fact that Shiseido already recognizes the outstanding effects of trehalose would motivate one even more so to further select hemicellulose since Hattori et al. has the same purpose as Shiseido: attaining a stable, moisture maintaining cosmetic using a water-soluble polymer. However, unlike Shiseido, Hattori et al. , recognizes conventional water-soluble polymers may not provide optimal results forming a stable cosmetic that maintains its moisture. Thus, Hattori et al. provides motivation for Shiseido to avoid conventional water-soluble polymers and select hemicellulose since it would provide better stability for a cosmetic, which is the goal of Shiseido.

11. With respect to Morimoto et al. ('969), '969 teaches a soybean protein/cocoa granule for a drink with either pullan or hemicellulose. Morimoto et al. ('516) also teaches a soybean protein/cocoa powder for preparing a drink comprising cocoa, pullan, and trehalose. However '516 teaches adding at least 5% trehalose, and up to 40%, to mask the soybean flavor in the cocoa. Thus, '516 provides motivation to add trehalose to the soybean mix of '969: to mask a soybean flavor found in soybean

protein/cocoa powders. The fact that applicant has recognized another advantage of this combination of hemicellulose and trehalose which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Madsen
Examiner
Art Unit 1761



MILTON I. CANO
SUPERVISORY PATENT EXAMINER
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